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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/738,801 | 12/15/2000 | William J. Beyda | 00 P 9081 US | 2375 |
| 7590 | 06/16/2004 | | EXAMINER SLOAN, NATHAN A | |
| Siemens Corporation Attn: Elsa Keller, Legal Administrator Intellectual Property Department 186 Wood Avenue South Iselin, NJ 08830 | | | ART UNIT 2614 | |
| | | | PAPER NUMBER | |

DATE MAILED: 06/16/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/738,801

Applicant(s)

WILLIAM J. BEYDA

Examiner

Nathan A Sloan

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's arguments filed 4/1/04 have been fully considered but they are not persuasive.

Applicant has amended claims 1, 4, 10, and 16 to indicate that the process of attaching a portion of video to email is automatic. Applicant presents corresponding arguments asserting that Budge fails to meet this feature because a user pushes or clicks a button to perform this action (response, p. 6). However, the process of Budge, even while requiring a user to perform a selection, is certainly "automatic" as claimed. That is, memory is accessed by the computer as is notoriously well known in the industry to automatically carry out user-initiated commands. This is distinguished from automatically accessing memory without any user commands. The fact that these are distinguished actions is further re-emphasized upon inspection of applicants arguments and claim 4. While applicant states that the amendment is intended to recite a process which automatically attaches the video file without interaction, claim 4 specifically recites "automatically attach[ing] said video images ... *responsive to a video e-mail command signal.*" This video e-mail command signal is directly met by Budge with a user pushing or clicking a button as applicant noted. Should applicant desire such a limitation that this step of the process is performed automatically, *without user interaction*, such a limitation should be provided. Correspondingly, previous grounds of rejection are upheld as addressed in detail below.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 4-7, 10-13, and 15-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Budge et al. (6.014.689).

Budge et al. teach an email system with a video email player that allows easy video capturing, storage, and transmission of media via email attachments.

With respect to claim 1, the claimed “playing a video on a video input device” is met by playing a video received from the video capture electronics 22, in Figure 1 from camera 20, on a PC 10. As seen in Figure 7A, a user may prompt the system to start and stop recording, claimed receiving an activate and deactivate signal. This process involves “digitizing and storing at least a portion of said video” during a record process as is well known and taught in col. 4:25+. Video email recorder 210 of Fig. 2 first stores files as a temporary file, which is compressed as claimed (col. 4:47-57). Input may then be provided to store the compressed file to a hard drive, as taught in col. 5:52+ through col.6:3. A user may then desire to “launch an email application” which will automatically access memory and “attach ... said video to an e-mail message” using the videolink software seen in Fig. 6, seen at 720 of Fig. 7A, and taught in col. 2:11-27 as well as throughout the specification.

With respect to claims 4, 10, and 16, the claimed "video input device" is seen in Figure 1 at item 20, the claimed monitor is seen at 14, the claimed Web Access device including an email module is met by PC 10, which as noted above in response to claim 1 may "receive video images from said video input device and automatically attach said video images to an e-mail responsive to a video e-mail command signal." These messages are formed as part of an email compose window as seen in Fig. 6. Additionally with reference to Fig. 1, it is seen that this system is coupled to a "local area network" comprising multiple systems 2 and 4.

With respect to claims 5 and 11, the claimed "e-mail command signal comprising a signal from a switch associated with said video input device" is met by user interaction via keyboard 18 and / or command signals inherent to the operation of PC 10 to control operation of system 2.

With respect to claims 6 and 12, the claimed receiving the e-mail command signal "from a remote control switch associated with said video input device" is met by keyboard 18 and / or mouse 19.

With respect to claims 7 and 13, the claimed video e-mail command signal coming from a signal from a button associated with a graphical user interface is met by selecting a program for operation and controlling using the GUI seen in Figure 6.

With respect to claim 15, the claimed Web Access Device being a personal computer is met by PC 10 of Figure 1.

With respect to claims 17 and 18, the claimed sending an email to "another entity on said LAN" or to "an entity external to said LAN" is taught in col. 4:5-19.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2, 3, 8, 9, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Budge (6,014,689).

With respect to claim 2, the claimed “user selecting a compression method” is not taught by Budge. Budge clearly teaches compression techniques for the video data as previously noted, but not allowing a user to select a compression method. Examiner takes Official Notice that it was notoriously well known in the art at the time of the invention to allow selection of a compression method. It would have been obvious for one skilled in the art at the time of the invention to modify the system and methods of Budge by allowing user selected compression methods in order to allow versatility in storage and transmission formats to ensure proper playback.

With respect to claim 3, the claimed “receiving a deactivate signal ... responsive to a timeout of a timer” is not taught by Budge. Examiner takes Official Notice that it was notoriously well known in the art at the time of the invention to use a timer as a deactivate signal. It would have been obvious for one skilled in the art at the time of the invention to modify the system and method of Budge by using a timer deactivate signal in order to simplify user tasks.

With respect to claims 8 and 14, the claimed monitor being a "television screen" is not taught by Budge. Examiner takes Official Notice that web/TV stations allowing email and television viewing on a television screen were notoriously well known in the art at the time of the invention. It would have been obvious for one skilled in the art at the time of the invention to modify the system and methods of Budge by allowing email over a television in order to provide users with a more encompassing unit and reduce costs associated with owning multiple devices to watch television and read email.

With respect to claim 9, the claimed Web Access Device being a personal computer is met by PC 10 of Figure 1.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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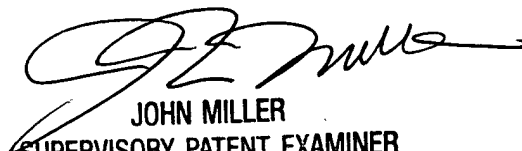
however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan A Sloan whose telephone number is (703) 305-8143. The examiner can normally be reached on Mon-Fri 7:30am - 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (703)305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NAS


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